

Remarks

This Amendment is responsive to the Final Office Action of **July 13, 2005** and the Advisory Action issued on **October 3, 2005**. Reexamination and reconsideration of **claims 1 and 3-22** is respectfully requested.

Summary of The Final Office Action

Claim 21 was rejected under 35 U.S.C. § 112, first paragraph, due to the term “telephone call.”

Claims 1-5 and 16-21 were rejected under 35 U.S.C. 102(e) as being anticipated by Bjorndahl (US 6,901,241).

Claims 6-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bjorndahl in view of Kim (US 2001/0031043).

Claims 11-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bjorndahl in view of Haartsen (US 6,028,853).

Summary of Examiner Interview

Applicant would like to thank the Examiner for the courtesies extended to Applicant's attorney during the telephonic interview of October 25, 2005. During the interview, the 35 U.S.C. § 112, first paragraph, rejection was discussed and the specification was reviewed. The Examiner agreed that the specification supported the claim language and would remove the rejection. The Applicant's previous response relating to the 35 U.S.C. § 112, first paragraph, rejection is repeated in the present response for the Examiner's convenience.

Independent claims 1, 11, 16, and 21 were also discussed. The Examiner indicated that the claims appear to distinguish over Bjorndahl but will review the reference again.

35 U.S.C. § 112, First Paragraph, Rejection

Claim 21 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action states that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Office Action states that there is no specific indication in the specification that states that a “telephone call” is “transmitted to a mobile phone in response to an error status that occurs during operation of the printing device”.

The Applicant respectfully submits that the present specification supports the feature that a telephone call is transmitted to a mobile phone as claimed. For example looking to the present application, paragraph [0018] describes a peripheral device (e.g. a printing device) that can “notify a mobile telephony device (e.g. mobile telephone, a cellular telephone, etc.)” when the peripheral device is in an error mode. Paragraph [0018] also describes using “a public switched telephone network (PSTN) (e.g., plain old telephone service (POTS))...”

One of ordinary skill would clearly understand that such telephone networks are used to transmit telephone calls. That is the intended purpose of such networks. Indeed, it is also well understood that the primary way to contact a telephone device is to “call” the device.

Paragraph [0030] of the present specification describes establishing a communication path between a peripheral device and a mobile telephony device. Starting at the fourth line, it states that “The communication signals are transmitted from the controller 22 to the mobile telephony device 14...as a function of the operating status of the peripheral device 12...” The last sentence of paragraph [0038] states “...the communication signals...identify a mobile telephony device (e.g., via a telephone number) to which the error message is to be sent.” One of ordinary skill in any art would understand that using a “telephone number” to communicate with a telephone involves transmitting a “telephone call” to the telephone. Therefore, claim 21 is supported by the specification.

Additionally, the last sentence of paragraph [0032] states that “...the user accesses (e.g., answers) the device 14.” One of ordinary skill in the art would clearly understand that a person “answers” a mobile telephone when the telephone receives a telephone call. As such, causing a telephone call to be transmitted to a mobile phone, as recited in claim 21, is supported by the specification.

Applicant respectfully submits that the specification reasonably conveys to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Claim 21 is believed to comply with all requirements of 35 U.S.C. § 112 and the rejection should be withdrawn.

The Present Claims Patentably Distinguish Over the References of Record

Independent Claim 21

Newly cited art was applied to the claims. In particular, claim 21 was rejected under 35 U.S.C. 102(e) as being anticipated by Bjorndahl. The Office Action, on page 5, cites column 7, lines 6-9 and Figure 4 and states that since the printer 50 can forward a message to the PC 48, the printer could also forward a message to the mobile phone 26.

Bjorndahl, however, uses a differently configured communication network and does not teach or suggest a printing device configured to cause a telephone call to be transmitted to a mobile phone as in claim 21. For example, Bjorndahl discloses a system where a secure wireless radio communication link is established between two devices where the link is “...an infrared link between the two devices...” (see column 3, lines 41-45). Thus, Bjorndahl teaches direct communication between devices that are interconnected to each other by a wireless link. This is very different from transmitting a telephone call as claimed.

Figure 4 of Bjorndahl shows “wirelessly interconnected devices” (column 7, line 59) that are interconnected by infrared transmissions (or Bluetooth). As Bjorndahl explains, these devices are in close proximity and require secure communications, which Bjorndahl tries to address. “The initial, more secured infrared transmissions of the present invention, requiring close proximity, more line-of-sight security data exchanges, provide the requisite level of protection necessary in these open-to-tampering systems.” (column 7, line 67 to column 8, line 2). One of ordinary skill would understand that this type of wireless communication between two interconnected devices is a completely different form of communication as compared to transmitting a telephone call, which is not performed.

Referring again to the Office Action at the top of page 5, it suggests that the printer 50 could forward a message to the mobile phone 26 (column 7, lines 1-9). If such a message were forwarded, it must be transmitted in a manner disclosed by Bjorndahl. Thus, the printer 50 would be wirelessly interconnected with the mobile phone 26 to send the message. A telephone call is not used or mentioned. Rather, the devices would be in close proximity to each other and probably in the line-of-sight (column 8, lines 1-2) so that the interconnected wireless link can function. This is how wireless links operate, which is a completely different form of communication than a telephone call.

The printer in Bjorndahl does not transmit a telephone call to the mobile phone and there is no mention of such a feature. Thus, there is no teaching or suggestion of a printing device comprising a controller configured to cause a telephone call to be transmitted to a mobile phone in response to an error status that occurs during operation of the printing device as recited in claim 21. The other cited references have also been reviewed and do not cure the shortcomings of Bjorndahl.

Since claim 21 recites features not taught or suggested by Bjorndahl, claim 21 patentably distinguishes over Bjorndahl. Thus, the rejection should be removed and claim 21 should be in condition for allowance.

Independent Claim 1

Claim 1 has been amended to incorporate language from dependent claim 2. Thus, no new matter has been added and the scope of the claims have not been changed. Claim 2 is now canceled.

Claims 1 and 2 were rejected under 35 U.S.C. 102(e) as being anticipated by newly cited Bjorndahl. The Office Action, at the bottom of page 3, states that Bjorndahl purportedly teaches a message transmitted over a telephone network 42 and cites Figure 4.

Applicant refers to the previous explanations of Bjorndahl. Bjorndahl discloses secure transmissions for devices that are wirelessly interconnected to each other (in close proximity, in line-of-sight). Figure 4 shows a variety of devices that may directly interconnect in pairs. The printer 50, as well as other devices, may directly communicate with a second device using interconnected wireless links. Column 7, lines 5-9 state that the printer 50 could forward a message to the PC 48, but this is performed by an interconnected wireless link with the PC 48. Indeed, Bjorndahl is limited to this type of communication. Thus, it can be said that Figure 4 suggests that the printer 50 could also wirelessly interconnect with home base station 40. But, there is no teaching or suggestion that the printer 50 can cause a message to be transmitted using a telephone call over a telephone network 42 to a mobile device. Such a function or feature is not part of Bjorndahl.

Based on the teachings of Bjorndahl, if the printer 50 wanted to communicate with the mobile device 26, it would establish an interconnected wireless link directly with the mobile device 26. There is nothing in Bjorndahl that suggests the printer 50 would transmit a message over a telephone network. Bjorndahl does not support such an interpretation and there is no teaching to perform this function. Therefore, printer 50 in Bjorndahl does not include a controller configured to cause a message to be transmitted over a telephone network to a mobile device as recited in claim 1, and no such controller is suggested.

Since claim 1 recites features not taught or suggested by the reference, claim 1 patentably distinguishes over the reference and is in condition for allowance. Accordingly, dependent claims 2-10 also patentably distinguish over the reference and are in condition for allowance.

Independent Claim 16

Claim 16 has been amended to recite a method for establishing a communication path between a printing device and a mobile device that comprises causing the communication path to be established between the printing device and the mobile device by transmitting a telephone call to the mobile device over a telephone network. This language is supported, for example, by original claim 2 and the specification as discussed under the 35 U.S.C. § 112, first paragraph, section above. Thus, no new matter has been added.

Claim 16 was rejected under 35 U.S.C. 102(e) as being anticipated by Bjorndahl. Based on the teachings of Bjorndahl described above, Bjorndahl fails to teach or suggest a method where a printing device causes a communication path to be established between the printing device and the mobile device by transmitting a telephone call to the mobile device over a telephone network as recited in claim 16. Bjorndahl only describes a printer 50 that can communicate with a mobile device 26 using an interconnected wireless link directly with the mobile device 26. Nothing in Bjorndahl suggests that the printer 50 can cause a telephone call to be transmitted to the mobile device. Therefore, claim 16 patentably distinguishes over Bjorndahl. Accordingly, dependent claims 17-20 also patentably distinguish over the reference and are in condition for allowance.

Independent Claim 11

Claims 11-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bjorndahl in view of Haartsen (US 6,028,853). Haartsen was cited for teaching a communication path that includes a path from the peripheral device to a local area network, to a gateway, to a public switched telephone network, and to the mobile device. Figure 1 and column 5, lines 27-35 was cited from Haartsen.

Haartsen does not disclose the claimed communication path and thus fails to cure the shortcomings of Bjorndahl. For example, Figure 1 and column 5, lines 27-35 describe an environment where the Haartsen invention is typically used (column 5, line 19). The environment is described as having separate network arrangements that “...share a limited space and a common air interface.” (column 5, lines 23-24).

Figure 1 shows a first arrangement that includes a portable phone 1 that can communicate with a PDA 3 and a home base station 2, which is connected to a telephone network (PSTN). These devices communicate using “two point-to-point links L1 and L2” (column 5, lines 26-31). Then Haartsen describes another separate arrangement that includes the printer 5 and the PC 4 at line 33 that states “there is another transceiver arrangement 9, consisting of a Personal Computer (PC) 4 and a printer 5.” The PC can have a wireless connection to the LAN 6.

In the disclosed environment, the two arrangements are not communicating with each other. Thus, the “printer-PC-LAN” arrangement does not establish communication channels with the “PDA-phone-home base station.” In fact, one purpose of the Haartsen invention is to try to reduce interference problems (column 5, line 40).

Applicant respectfully submits that Haartsen fails to disclose the claimed communication path. There is no communication path from the printer 5 to the LAN 6, to a gateway (no gateway disclosed), to the public switched telephone network (PSTN), and to the portable phone 1. This is further evidenced since Haartsen only mentions the printer 5 one time (column 5, line 35) and is not concerned with how the printer operates. Thus, there is no teaching or suggestion in Haartsen to establish the claimed communication path between a peripheral device and a mobile phone. There is no reason to establish such a path and one of ordinary skill would find no evidence to support such an interpretation of Haartsen. Therefore, combining Bjorndahl with Haartsen still fails to cure the shortcomings of Bjorndahl.

Since Bjorndahl and Haartsen fail to teach or suggest the recited features of a peripheral device, Bjorndahl and Haartsen fail to teach or suggest a computer program product operable

within a peripheral device as recited in claim 11. Therefore, claim 11 patentably distinguishes over the references. Accordingly, dependent claims 12-15 also patentably distinguish over the references and are in condition for allowance.

Dependent Claim § 103 Rejections

Claims 6-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bjorndahl in view of Kim (US 2001/0031043). As claims 6-10 depend from claim 1, the arguments above apply equally to these claims. Accordingly, dependent claims 6-10 patentably distinguish over Bjorndahl in view of Kim and are in condition for allowance.

The references of record that were cited but not applied to the claims have been considered. None of the references, individually or in combination with other references, teach or fairly suggest the present claims.

Conclusion

For the reasons set forth above, **claims 1 and 3-22** patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

Oct. 31, 2005



PETAR Kraguljac (Reg. No. 38,520)
(216) 348-5843